



DEPARTMENT OF COMMERCE

Patent and Trademark Office

[Docket No.: PTO-P-2022-0002]

Filing Patent Applications in DOCX Format

AGENCY: United States Patent and Trademark Office, Department of Commerce.

ACTION: Notice.

SUMMARY: The United States Patent and Trademark Office (USPTO) recently announced a delay in the effective date of the surcharge fee for certain patent applications that are not filed in DOCX format until January 1, 2023. During the period before the non-DOCX filing surcharge fee becomes effective, the USPTO is encouraging applicants to begin filing patent applications in DOCX format. To address concerns some applicants have raised and to allow applicants to get acclimated to the process of filing applications in DOCX format, the USPTO is providing applicants with the option, on a temporary basis, to submit an applicant-generated PDF version of the application along with the DOCX file(s) when filing an application in Patent Center.

DATES: *Applicable date:* [INSERT DATE OF PUBLICATION IN FEDERAL REGISTER]

Duration: The option to submit an applicant-generated PDF of the application along with the DOCX file(s) when filing an application in Patent Center, as discussed in this notice, will be available through December 31, 2022.

FOR FURTHER INFORMATION CONTACT: Mark O. Polutta, Senior Legal Advisor, Office of Patent Legal Administration, at 571-272-7709; or Eugenia A. Jones, Senior Legal Advisor, Office of Patent Legal Administration, at 571-272-7727.

For technical questions about submitting documents in DOCX format, please contact the Patent Electronic Business Center (EBC) at 1-877-217-9197 (toll-free), 571-

272-4100 (local), or ebc@uspto.gov. The EBC is open from 6 a.m. to midnight ET, Monday through Friday.

SUPPLEMENTARY INFORMATION: The USPTO published a final rule in the Federal Register that included a new non-DOCX filing surcharge fee, set forth in 37 CFR 1.16(u), with an effective date of January 1, 2022. *See* Setting and Adjusting Patent Fees During Fiscal Year 2020, 85 FR 46932 (August 3, 2020) (Patent Fee Setting final rule). This surcharge fee is due for any non-provisional utility application filed under 35 U.S.C. 111 (other than a reissue application) on or after the effective date, when the specification, claims, and/or abstract do not conform to the USPTO requirements for submission in DOCX format. The USPTO recently announced it was delaying the effective date of this fee until January 1, 2023. *See* Setting and Adjusting Patent Fees During Fiscal Year 2020, 86 FR 66192 (Nov. 22, 2021). This will enable the USPTO to perform additional monitoring and evaluating of its information technology systems, and to give applicants more time to adjust to filing patent applications in DOCX format.

The USPTO continues to work with its stakeholders to transition to the DOCX format. Through this notice, the USPTO is providing applicants with the option to submit an applicant-generated PDF of the application along with the validated DOCX file(s) when filing an application in Patent Center, from the effective date of this notice through December 31, 2022 (the temporary period). This option will not be available for applications filed via EFS-Web. This will allow applicants to gain confidence in the reliability and accuracy of the USPTO system when filing applications in DOCX format, and safeguard the applicant should any conversion discrepancies have taken place.

Patent Center is the new tool for the electronic filing and management of patent applications that will eventually replace EFS-Web and the Patent Application Information Retrieval (PAIR) system. Patent Center offers a number of benefits to applicants. For example, when filing documents in DOCX in Patent Center, applicants do

not have to manually separate the sections of the document into the specification, claims, and abstract. Additional information on Patent Center is available at www.uspto.gov/patents/apply/patent-center.

The DOCX User Guide posted on the USPTO website explains that during the filing process, an applicant initially uploads a DOCX file(s) containing the specification, claims, and abstract. The DOCX file(s) undergoes preliminary validation, in which metadata is removed, non-substantive changes (e.g., acceptance of track changes in initial filings, removal of comments and bookmarks) may be made, and a validated DOCX file(s) is created. In addition, a feedback document is generated to provide warnings, identify common errors, such as formatting errors, and provide instant feedback to the applicant to prevent unnecessary delays in processing. In order to improve processing efficiency and provide an enhanced user experience for stakeholders, the USPTO system currently creates a consistently formatted PDF version of the specification, claims, and abstract during the filing process that will be made available both before filing and in the application file after the application has been filed. By transitioning to DOCX the applicant benefits from improved application quality and management as described at: <https://www.uspto.gov/patents/docx>. The USPTO continues to evaluate how best to implement changes to the format of application files used during examination based on DOCX submissions.

The USPTO previously published a notice which sets forth that the USPTO considers the validated DOCX file(s) submitted by the applicant to be the authoritative document and that applicants may rely on the validated DOCX file(s) as the source or evidentiary copy of the application to make any corrections to the documents in the application file. *See Submitting Patent Applications in Structured Text Format and Reliance on the Text Version as the Source or Evidentiary Copy*, 86 FR 29571 (Jun. 2, 2021). Thus, applicants already have the ability to rely on the validated DOCX file(s)

they submitted to correct any errors or discrepancies that result from the USPTO's conversion of the DOCX file(s) to a PDF(s). If there is an error or discrepancy in the record that resulted from filing an application in DOCX format, the applicant should promptly notify the EBC at 1-866-217-9197 (toll-free), 571-272-4100 (local), or ebc@uspto.gov so the EBC can investigate the issue(s).

Applicants who choose to submit an applicant-generated PDF with the validated DOCX file(s) when filing an application in Patent Center during the temporary period will not have to pay any additional fees, such as an application size fee, as a result of filing the applicant-generated PDF, and, on petition, will be able to rely on the applicant-generated PDF if a discrepancy occurs during the filing process. Please note that if an applicant makes changes to the DOCX file(s) prior to filing the application as a result of the validation process, then the applicant should ensure that the applicant-generated PDF corresponds to the revised DOCX file(s). Once the non-DOCX filing surcharge fee becomes effective on January 1, 2023, applicants who submit an applicant-generated PDF with the validated DOCX file(s) will need to pay the non-DOCX filing surcharge fee and any other additional fees as a result of filing the applicant-generated PDF. As December 31, 2022, approaches, the USPTO will evaluate whether there is a need to extend the temporary period beyond December 31, 2022, and will inform the public of any extension of the temporary period.

Under this temporary new process of allowing applicant to optionally submit the applicant-generated PDF, the USPTO has created a new document description for the optional applicant-generated PDF submitted with the DOCX file(s) during the temporary period. This new document description is "Auxiliary PDF of application," and the corresponding document code is AUX.PDF. If filing an applicant-generated PDF in Patent Center, it should be a single PDF and contain all the sections being filed in DOCX format. Use of this document description by applicants will facilitate recognition of the

document in the application file and will avoid confusion with the specification, claims, and abstract that are to be used during examination and publishing.

As stated above, applicants can rely on the validated DOCX file(s) as the source or evidentiary copy to make corrections to the record when any discrepancies are identified between the source or evidentiary copy and the documents the USPTO has converted. Applicants may need to file a petition under 37 CFR 1.181 to make a correction to the record, which is supported by the validated DOCX file(s). *See* 86 FR 29571. However, if a correction to the record is needed due to an error or discrepancy that is not supported by the validated DOCX file(s), but is instead only supported by the applicant-generated PDF filed during the temporary period, the applicant should file a petition under 37 CFR 1.182 that identifies how the applicant-generated PDF supports the requested correction to the record. In addition, such a petition under 37 CFR 1.182 must be accompanied by an amendment to the specification, claims, or abstract to correct the record as desired, unless such an amendment was previously submitted. Amendments to the application must comply with 37 CFR 1.121. The USPTO will waive the fee under 37 CFR 1.17(f) for this petition when an applicant is relying on an applicant-generated PDF, filed in Patent Center during the temporary period, as the source to make a correction to the record. As stated above, this will allow applicants to gain confidence in the reliability and accuracy of the USPTO system when filing applications in DOCX format, and safeguard the applicant should any conversion discrepancies have taken place.

The applicant-generated PDF that accompanies a DOCX filing will not become part of the permanent record unless a petition is filed requesting the USPTO to correct the record in view of the applicant-generated PDF. In the absence of such a petition, the USPTO will dispose of the applicant-generated PDF, and all copies thereof, after a retention period of at least three years after the patent grant or abandonment of the application.

Applicants are strongly encouraged to review their applications, including the USPTO-generated PDF, shortly after filing the application to identify any errors or discrepancies in the record, as discussed above. The applicant should file any necessary petition to correct the record early in prosecution and promptly after discovering any errors or discrepancies.

As an alternative to filing a petition, applicants may be able to correct discrepancies resulting from filing an application in DOCX format by relying on a proper priority or benefit claim. A proper priority or benefit claim under 37 CFR 1.55 or 37 CFR 1.78 to a prior-filed application that is present on the filing date of the application is considered an incorporation by reference of the prior-filed application as to any inadvertently omitted portion of the specification or drawing(s), subject to the conditions and requirements of 37 CFR 1.57(b). Therefore, in some instances, discrepancies resulting from filing an application in DOCX format may be addressed by amending portions of the specification pursuant to the incorporation by reference provisions of 37 CFR 1.57(b), in lieu of a petition. The amendment should be identified as an amendment under 37 CFR 1.57(b), and it must comply with 37 CFR 1.57(b) and 37 CFR 1.121.

The USPTO continues to host training sessions on filing documents in DOCX. Information on filing application documents in DOCX, as well as information on how to submit an applicant-generated PDF and a link to the DOCX training sessions, is available at www.uspto.gov/patents/docx.

Kathi Vidal,

Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

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